



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/007,128 | 12/03/2001 | G. Scott Taylor | B0932/7185/REH/AWM | 2160 |

23628 7590 12/16/2003

WOLF GREENFIELD & SACKS, PC
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON, MA 02210-2211

EXAMINER

CAMPBELL, KELLY E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3618

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,128

Applicant(s)

TAYLOR ET AL.

Examiner

Kelly E Campbell

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-134 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-37 is/are allowed.
- 6) ☒ Claim(s) 1-21 and 38-134 is/are rejected.
- 7) ☒ Claim(s) 16-19, 32-35, 52-55, 72-75, 92-95 and 114-117 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Objections

Claims 16-19, 32-35, 52-55, 72-75, 92-95 and 114-117 are objected to because of the following informalities:

Claims 16, 32, 52, 72, 92 and 114 disclose "...having an enhanced property...";

Claims 17, 33, 53, 73, 93 and 115 disclose "...upper portion of said snow gasket has improved stretch properties...";

Claims 18, 34, 54, 74, 94 and 116 disclose "...intermediate portion of said snow gasket has improved abrasion resistance...";

Claims 19, 35, 55, 75, 95 and 117 disclose "lower portion has improved durability properties...";

and, it is unclear how the applicant intends to define the terms "enhanced" or "improved" as relates to the structure of the invention. Simply stating that an element of an invention has "enhanced" or improved stretch properties, for example, does not distinguish between increased stretch ability or decreased stretch ability. Whether or not a property is "enhanced" or "improved" is directly related to the application for which the material is being used. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3618

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11,13-20,38-47,49-56,58-67,69-76,78-87,89-96,98-109,111-118,120-125 and 127-134 are rejected under 35 U.S.C. 103(a) Messmer (US 6,138,384) in view of Bell et al (US 5,317,820).

Messmer teaches a snowboard boot binding (2) including:

a base (3) having a foot receiving area , see Figure 1, including a floor that is constructed and arranged for mounting the snowboard boot binding to a snowboard, see Column 3, lines 26-27, the snowboard binding (2) including:

a rear support member (5) for surrounding at least a portion of a rider's leg and which extends rearwardly and upwardly from the base floor (3), see Figure 1, wherein an opening (silent) shown in Figure 1, extends between a rearward edge of the base floor (3) and the rear support member (5), the opening (silent) adapted to receive at least a portion of a heel end (15) of a snowboard boot (9) that has been inserted into the boot binding, see column 3, lines 29-34 and lines 47-62;

wherein the base (3) includes rigid rear, medial, lateral walls and floor, silent, see Figure 1, see column 3, lines 21-25;

a boot engagement member (6,7,8) for securing the snowboard boot to the binding (2);

wherein the boot engagement member (6,7,8) includes at least one of a strap-type member (8);

a snow gasket (12) for covering at least a portion of the opening (silent) to prevent snow from passing through the opening and a boot engagement member;

Art Unit: 3618

and wherein the rear support member (5) is a heel loop and integrally formed with the base (3), see Figure 1;

and wherein the snow gasket (12) includes a floor or bottom edge, and a bottom of the snow gasket floor (silent) is located above a bottom rearward edge of the base floor (3) since the gasket (12) is disposed on top of the base floor (3), see Figure 1;

wherein the snow gasket (12) includes a rear end or rear wall, a lateral side or sidewall, a medial side or sidewall, and a floor, see Figure 1,

wherein a lower end (12) of the snow gasket is composed of rubber or similar material and thus has variable shape and is compliant and will assume the general shape of a heel end of a snowboard boot (9) upon insertion of the snowboard boot (9) into the snowboard binding (2), see Column 3, lines 29-55;

wherein the heel portion of the snow gasket (12) is cup-shaped;

the snow gasket (12) is removably attached to the base (3), see Figure 2,

the snow gasket (12) has an upper region (11) composed of a material different than the lower region (12) and having a different elasticity, durability and abrasion resistance, see Column 3, lines 35-45;

wherein the snow gasket (12) includes a lower end and an upper end (11) and the snow gasket (12) is biased towards an upper end, see Figure 2;

and wherein the snow gasket (12) includes a frame (13), see Figure 2.

Messmer teaches all aspects of the claimed invention except the snow gasket being separate from the snowboard boot.

Art Unit: 3618

Bell et al teaches a boot (60) having an additional sole member (28) for covering the heel portion (16) of the base (12), separate from and attachable to the boot (60) and disposed between the boot (60) and base (12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the boot binding configuration taught by Messmer such that the snow gasket is separate from the boot, for added support and cushion of the users boot and it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177,179.

With regards to claim 4, Messmer discloses all aspects of the claimed invention as discussed above for claim 2, except the rear support member of the snowboard binding being separate and distinct from the base.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the rear support member of the binding to be a separate and distinct component from the base, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177,179.

With regards to claims 99 and 101, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the snow gasket to be the same as the rigid plastic material of the rigid heel insert (13) and base plate (3), see Column 3, lines 47-54, the since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With regards to claims 120-125 and 127-134, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

Claims 21,57,77, 97 and 119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messmer (US 6,138,384) in view of Bell et al (US 5,317,820) as applied to claim 1,38,58 or 78 above, and further in view of Laughlin et al (US 6,123,354).

Messmer discloses all aspects of the claimed invention as discussed above for claim 1,38,58 and 78, except the binding including a strapless member.

Laughlin et al teaches a snowboard binding (3) including a base (11) having a foot receiving member, rear support heel loop and a strapless boot engagement members (7), see Column 4, lines 60-67.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the boot binding with a strap engagement member with a strapless engagement member as taught by Laughlin et al in order to more securely fix the boot to the snowboard binding for safety purposes.

Claims 12,48,68,88,110 and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messmer (US 6,138,384) in view of Bell et al (US 5,317,820) as

Art Unit: 3618

applied to claims 11,47,57,87 or 125 above, and further in view of Gonthier (US 6,402,164).

Messmer discloses all aspects of the claimed invention as discussed above for claim 11,47,57,87 and 125 except the snow gasket including a mesh-type fabric.

Gonthier discloses a snowboard binding including a rear portion (19) comprised of a "mesh-type" fabric, see Figure 1.

Mesh is defined as " a woven, knit or knotted material of open texture with evenly spaced holes", per Merriam-Webster's Collegiate Dictionary, 10th edition, © 2000.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the snowboard binding with gasket having an upper fabric section and lower rubber section as taught by Messmer such that the fabric section is a mesh-type fabric as taught by Gonthier, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

Applicant's arguments with respect to claims 1-21,38-97 and 120-134 have been considered but are moot in view of the new ground(s) of rejection.

The addition of limitations simply citing the "snow gasket" as an element "separate" from the applicant's boot are not patentably distinct or specific to the structural relationship between the snow gasket, the boot binding and the boot.

With regards to claim 98, the applicant has not specifically claimed the relationship between the snowboard binding and the gasket, as otherwise clearly expressed in claim 22. The limitations recited in claim 98 do not disclose, the snow gasket being mounted directly to the baseplate and positioned at least partially in the opening that extends between the heel loop and a rearward edge of the baseplate floor, wherein the snow gasket is separate from the boot, in addition to the other claim limitations. The applicant should consider including the above language within claim 98, to clearly illustrate the novelty of the applicant's invention.

Allowable Subject Matter

Claims 22-37 are allowed.

The following is an examiner's statement of reasons for allowance: The primary reason for allowance is the applicant's amendment to claim 22, reciting a baseplate including a floor for mounting to a snowboard, a medial sidewall, a lateral sidewall, and a heel hoop for surrounding at least a portion of a rider's leg and which extends rearwardly and upwardly from , the baseplate floor, wherein an opening extends between the heel hoop and a rearward edge of the floor that is adapted to receive at least a portion of a heel end of a snowboard boot, inserted into the binding; and a snow gasket "mounted to the baseplate", positioned at least partially in the opening, the snow gasket being separate from the snowboard boot and having a floor with a bottom

Art Unit: 3618

surface located above a bottom surface of the rearward edge of the baseplate floor. The prior art does not disclose the snow gasket directly mountable to the snowboard binding. A combination of these and other limitations have not been reasonably found within the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

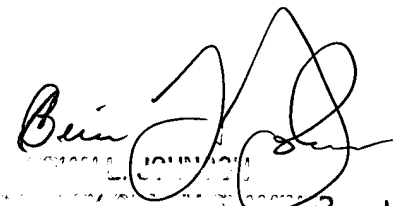
Art Unit: 3618

Any inquiry concerning this communication or earlier communications from the -
examiner should be directed to Kelly E Campbell whose telephone number is (703) 605-
4264. The examiner can normally be reached on 9:00-5:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone number
for the organization where this application or proceeding is assigned is (703) 872-9326.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is (703) 308-
1113.


KEC


BRIAN JOHNSON
SUPERVISOR
TECHNICAL CENTER 8800
12/15/00